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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/080,816 | 02/21/2002 | Michael S. Wiltshire | M-7001-IP US | 2619 |
| 23639 | 7590 | 12/18/2003 | EXAMINER | |
| BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO, SUITE 1800 SAN FRANCISCO, CA 94111-4067 | | | HARRISON, JESSICA | |
| | | ART UNIT | | PAPER NUMBER |
| | | 3714 | | |
| DATE MAILED: 12/18/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/080,816 | WILTSHIRE ET AL | |
| | Examiner | Art Unit | |
| | Jessica J. Harrison | 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____.

DETAILED ACTION

This application is a continuation of 09/199,529, now US Patent 6,409,602, which is a continuation-in-part of 09/187135 now abandoned.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 28 – 41 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of prior U.S. Patent No. 6,409,602. This is a double patenting rejection.

Although the claims are worded slightly differently, claim 28 appears identical in scope to prior claim 1. Specifically, claim 28 recites in combination:

one or more client/terminal computers connected to one or more server/host computers via communication pathways;

while patent claim 1 recites in combination:

one or more server/host computers;
one or more client/terminal computers for connection to the server/host computers via communication pathways;

The remaining language in each set of claims is identical. Both claims are defining at least one server, at least one client and connections on both computers via a pathway. Neither claim could be literally infringed without infringement of the other. Applicant should address the difference in scope or amend the claims to clearly be of different scope.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,409,602. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are only minor differences in scope between the claims and the differences are of the nature of rephrasings and omissions resulting in a slight broadening of scope. For example, the instant claims rephrase the connections and omit the recitation of the program executed on the client/terminal. It has long been considered to be

obvious to one of ordinary skill in the art to omit an element and its corresponding function from a claim by legal precedent. For example, See In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42 – 44 and 51 - 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Menashe '937.

Menashe discloses a system for providing interactive gaming applications over a wide area network utilizing a client/server setup. Data is received on the client computers and is transmitted over the pathway to the server. The program is a casino gaming program and wagers are accepted. The system operates over a WAN which inherently encompasses a global net.

The system utilizes packet data transfer which implies the world wide web and use of the internet as infrastructure. Note that the examiner sees the claimed method to be the steps of receiving and transmitting data. How that data is processed prior to/after transmission/reception is not limiting to the method as presently claimed. Therefore, Menashe is deemed to anticipate the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45 – 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menashe in view of Itkis '787 and the well known Windows operating system.

While Menashe includes a wager acceptor device (input keyboard) as recited in claim 46, he fails to discuss the display device of his terminal as is recited in claim 45. Menashe does disclose the use of a personal computer and clearly must include a display device to be operative. Further, Menashe suggest playing one game at a time and does not contemplate multiple games or windowing (receiving two types of data as claimed). In an analogous gaming server/client system, Itkis illustrates that it is known and advantageous to

provide multiple games to a player to maintain player interest, and to allow simultaneous play through a windowing environment, and to provide ease of player input through the use of touch screen input device. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide touch screen input on the PC of Menashe as such is a well known easy input interface and such would enhance the use of the Menashe system/games. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to enhance Menashe by providing multiple games in windows as is advantageously suggested by Itkis. In looking to make this modification, as packet data is utilized in Menashe and such is readily compatible with well know PC operating systems such as Windows 98, for example, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Windows 98 to provide for the reception and display of two types of game data into windows and sub windows in order to implement the Itkis suggestions on the Menashe system while utilizing the technology most commonly found in homes at the time of the invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art cited is related to other client/server gaming arrangements. Applicant should consider including the data processing steps which distinguish and define his invention into the claims rejected over prior art as well as alter the scope of statutorily identical claims and submit a

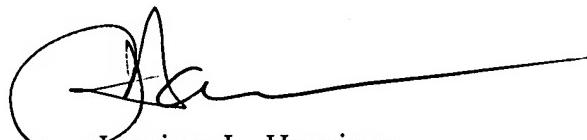
Art Unit: 3714

terminal disclaimer with respect to the application in order to overcome the rejections of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh